

### **REMARKS**

Claims 1-35 are cancelled. New claims 36 to 41 correspond to old claims 12-24. The amendment of the existing claims does not affect inventorship. In addition, this response is filed with a continuation application that claims priority to 09/782,004, filed on 02/12/2001; which claims benefit of 60/181,630, filed on 02/10/2000; and claims benefit of 60/186,904, filed on 03/03/2000; and claims benefit of 60/197,851, filed on 04/14/2000; and is a CON of 09/419,351, filed on 10/15/1999, now PATENT NO. 6,403,312; which claims benefit of 60/158,700, filed on 10/08/1999; and said 09/782,004, filed on 02/12/2001 claims benefit of 60/104,612, filed on 10/16/1998.

#### **Claim Rejections – 35 USC § 112, first and second paragraph**

Claims 12, 13, 21-24 and 33-35 are rejected under 35 USC § 112, first and second paragraphs for the recitation of “selecting”. The claims have been amended and thus the rejection is believed moot.

#### **Claim Rejections – 35 USC §§ 101/112-1**

Claims 12, 13, 21-24 and 33-35 are rejected under 35 USC § 101 as not being supported by either a specific asserted utility or a well established utility.

Independent claim 37 recites a step of synthesizing the secondary library and screening for at least one desired protein attribute, and thus the Applicants respectfully submit that the claims meet the patentability requirements under 35 USC § 101. As such, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 101/112-1.

#### **Claim Rejections – 35 USC §§ 101**

Claims 12, 13, 21-24 and 33-35 are rejected under 35 USC § 101 as being directed to non-statutory subject matter.

Independent claim 37 now recites a step of synthesizing the secondary library and screening for at least one desired protein attribute. Applicants respectfully submit that the claims, as amended, meet the patentability requirements under 35 USC § 101. As such, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 101.

Serial No.: 09/782,004  
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### **Claim Rejections – 35 USC §§ 102 and 103**

The rejection of Claims 12, 13, 21-24 and 33-35 under 35 USC §§ 102 and 103 as being anticipated by Lacroix was temporarily withdrawn in view of the amended claims.

However, the response is accompanied by a request for continuation application, which amends the priority claim of the present application to

As such, Lacroix is removed as a prior art reference, and Applicants believe the amended claims meet all the requirements for patentability.

### **Double Patenting**

Claims 12 and 21-24 and 33-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-29 of co-pending application no. 09/927790.

Applicant respectfully requests that the claim scope be reevaluated once the claims of both applications are in condition for allowance.

The Applicants submit that in light of the above-amendment and argument, the claims are now in condition for allowance and an early notification of such is respectfully solicited.

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